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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/737,244

Filing Date: December 16, 2003

Appellant(s): BRESNAN ET AL.

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Michael J. Cummings  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 08, 2008 appealing from the Office action mailed October 16 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,058,030	Schumacher	10-1991
2004/0230523	Johnson	11-2004
2002/0133472	Stepno	9-2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-6, 12-16, 21-24, 31, 34, 36, 37, 39-41, 50-54, 59-62, 69, 72, 74 and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat No. 5,058,030 to Schumacher.

#### **Referring to claim 2:**

The message processing system of claim 3 wherein the distributor module is programmed to format the consolidated message packages in accordance with the determined optimal routing. (col 10: lines 18-27)

#### **Referring to claim 3:**

A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

A distributor module couple to the consolidator module and receiving a data stream containing consolidated message packages, the distributor module programmed to determine optimal routing for production of message packages based on second criteria. (col 10: lines 18-27)

wherein the recipients are customers and the consolidator module and the distributor are coupled to a customer relationship management system, the customer relationship management system determining at least some of the first and second criteria. (col 10: lines 20-27)

**Referring to claim 4:**

The message processing system of claim 3 wherein the customer relationship management system determines a template for message packages and the template is transmitted to the consolidator module for forming the message packages. (col 10: lines 31-40)

**Referring to claim 5:**

The message processing system of claim 4 wherein the template includes marketing content developed by marketing tools in the customer relationship management system. (col 10: lines 31-40)

**Referring to claim 6:**

The message processing system of claim 3 wherein the first and second criteria include marketing business rules determined by the customer relationship management system. (col 4: lines 15-21)

**Referring to claim 12:**

A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidating the message based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

A distributor module coupled to the consolidator module and receiving a data stream containing consolidated message packages, the distributor module programmed to determine optimal routing for production of message packages based on second criteria. (col 10: lines 18-27)

wherein the consolidator module and the distributor are coupled to a statement applications processing module, the statement applications processing module determining at least some of the first and second criteria. (col 10: lines 6-18; col 11: lines 8-11)

and

wherein the first and second criteria include sender rules received from the statement applications processing module. (col 10: lines 6-18)

**Referring to claim 13:**

The message processing system of claim 12 wherein the statement applications processing module provides message business data to the consolidator module for forming the message packages. (col 11: lines 8-11)

**Referring to claim 14:**

The message processing system of claim 12 wherein the statement applications processing module receives data from an automated data factory having a plurality of mail production sites. (col 11: lines 5-11)

**Referring to claim 15:**

The message processing system of claim 14 wherein the distributor module receives postal delivery metrics, and wherein the distributor module calculates transit times for message delivery from the plurality of mail production sites. (col 4: lines 15-21)

**Referring to claim 16:**

The message processing system of claim 14 wherein the second criteria includes quality requirements and wherein the distributor module receives service and quality metrics corresponding to the plurality of mail production sites, and wherein the distributor module routes message packages based on sites meeting the quality requirements. (col 4: lines 15-21)

**Referring to claim 21:**

The message processing system of claim 12 wherein the sender rules include a requirement to minimize time for delivery of messages to recipients, and whereby the consolidator module and distributor module form and route message packages in order to minimize time for delivery. (col 10: lines 22-26)

**Referring to claim 22:**

The message processing system of claim 12 wherein the sender rules include a requirement to maximize throughput of message packages, and whereby the

consolidator module and distributor module form and route message packages in order to maximize throughput. (col 4: lines 22-39)

**Referring to claim 23:**

The message processing system of claim 12 wherein the sender rules include a requirement to minimize mail production costs, and whereby the consolidator module and distributor module form and route message packages in order to minimize mail production costs. (col 4: lines 15-21)

**Referring to claim 24:**

The message processing system of claim 12 wherein the consolidator selects messages for consolidation from the plurality of messages based on the messages including a same delivery address. (col 10: lines 31-40)

**Referring to claim 31:**

The message processing system of claim 12 wherein the distributor module determines optimal site routing based on real time site production data. (col 10: lines 6-15)

**Referring to claim 34:**

A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

A distributor module couple to the consolidator module and receiving a data stream containing consolidated message packages, the distributor module programmed to determine optimal routing for production of message packages based on second criteria. (col 10: lines 18-27)

wherein the distributor module determines optimal site routing based on historical site production data. (col 4: lines 15-20)

**Referring to claim 36:**

The message processing system of claim 34 wherein the distributor module determines optimal site routing based on historical costs of site operation. (col 4: lines 15-20)

**Referring to claim 37:**

The message processing system of claim 34 wherein the distributor module determines optimal site routing based on postal service delivery time data for respective sites. (col 4: lines 15-20)

**Referring to claim 39:**

The method of claim 41 wherein the step of determining optimal routing includes designating electronic presentment of the message packages and the step of transmitting includes electronic presentment of the message packages. (col 11: lines 7-10)

**Referring to claim 40:**

The method of claim 41 further comprising the step of formatting the consolidated message packages in accordance with the determined optimal routing. (col 11: lines 6-13)

**Referring to claim 41:**

A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

Receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

Consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

Determining optimal routing for production of message packages based on second criteria; (col 10: lines 18-27)

Transmitting the message packages to one or more of a plurality of message production sites based on the optimal routing. (col 10: lines 18-27; col 11: lines 7-10)

determining at least some of the first and second criteria through a customer relationship management system. (col 4: lines 9-21)

**Referring to claim 50:**

A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

Receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

Consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

Determining optimal routing for production of message packages based on second criteria; (col 10: lines 18-27)

Transmitting the message packages to one or more of a plurality of message production sites based on the optimal routing. (col 10: lines 18-27; col 11: lines 7-10)

determining at least some of the first and second criteria with a statement applications processing module. (col 10: lines 22-26)

wherein the step of determining at least some of the first and second criteria includes incorporating sender rules received from the statement applications processing module. (col 10: lines 6-18)

**Referring to claim 51:**

The method of claim 50 further including the step of providing message business data from the statement applications processing module for forming the message packages. (col 10: lines 22-26; col 11: lines 7-11)

**Referring to claim 52:**

The method of claim 50 further including the step of receiving data from an automated data factory controlling the plurality of mail production sites, and using said automated data factory data for determining said optimal routing. (col 10: lines 10-16)

**Referring to claim 53:**

The method of claim 52 further including receiving postal delivery metrics, and the step of determining optimal routing includes calculating transit times for message delivery from the plurality of mail production sites. (col 4: lines 15-21)

**Referring to claim 54:**

The method of claim 52 further including the steps of:  
Receiving service and quality metrics corresponding to the plurality of mail production sites. (col 10: lines 10-16)

Including quality requirements in the second criteria (col 10: lines 10-16)

Determining the optimal routing of message packages based on sites meeting the quality requirements. (col 4: lines 15-21; col 10: lines 10-16)

**Referring to claim 59:**

The method of claim 50 wherein the sender rules include a requirement to minimize time for delivery of messages to recipients, and the steps of consolidating and determine optimal routing are controlled to form and route messages packages in order to minimize time for delivery. (col 4: lines 15-21; col 10: lines 22-26)

**Referring to claim 60:**

The method of claim 50 wherein the sender rules include a requirement to maximize throughput of message packages, and the steps of consolidating and determining optimal routing are controlled to form and route message packages in order to maximize throughput. (col 4: lines 22-39)

**Referring to claim 61:**

The method of claim 50 wherein the sender rules include a requirement to minimize mail production costs, and the steps of consolidating and determining optimal routing are controlled to form and route message packages in order to minimize mail production costs. (col 4: lines 15-21)

**Referring to claim 62:**

The method of claim 50 wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address. (col 4: lines 35-40)

**Referring to claim 69:**

The method of claim 50 wherein the step of determining optimal routing is based on real time site production data received from the plurality of message production sites. (col 10: lines 10-15)

**Referring to claim 72:**

A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

Receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

Consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

Determining optimal routing for production of message packages based on second criteria; (col 10: lines 18-27)

Transmitting the message packages to one or more of a plurality of message production sites based on the optimal routing. (col 10: lines 18-27; col 11: lines 7-10) wherein the step of determining optimal site routing is based on historical site production data. (col 4: lines 15-21)

**Referring to claim 74:**

The method of claim 72 wherein the step of determining optimal site routing is based on historical costs of site operation. (col 4: lines 15-20)

**Referring to claim 75:**

The method of claim 72 wherein the step of determining optimal site routing is based on postal service delivery time data for respective sites. (col 4: lines 15-21)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 18, 19, 32, 33, 35, 42-45, 56, 57, 70, 71 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher.

**Referring to claim 7:**

Schumacher does not expressly disclose that the message processing system of claim 6 wherein the marketing rules include a rule that message including particular marketing content may, or may not, be consolidated.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of certain market content not to be consolidated. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient as market contents could contain personal information of the recipient.

**Referring to claim 18:**

Schumacher does not expressly disclose that the message processing system of claim 17 wherein the first criteria include a sender rule that messages including particular business content may, or may not, be consolidated.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business content not to be consolidated. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient as business contents could contain personal information of the recipient.

**Referring to claim 19:**

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a sender rule that messages that include particular business content may, or may not, be householded.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business content not to be householded.

As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not allowing information about multiple recipients to be sent to the same address and risking compromising recipient information.

**Referring to claim 32:**

Schumacher does not expressly disclose the message processing system of claim 31 wherein the distributor module determines whether a site or a machine at a site is non-operational, and wherein the second criteria include a failover site or channel designation, and whereby the failover site or channel designation is used for optimal routing instead of the non-operational site or machine.

However, it would have been obvious at the time of the invention for Schumacher to monitor and determine whether a site is operational and direct the mailing jobs to another site if the first site is not operation. Schumacher would be motivated to perform such method to ensure continuous job processing. Schumacher provides further motivation by disclosing that "due to continuous on-line communications, the data center can choose an inserter for a particular job and take into account not only equipment and other resources available to each inserter, but also current workloads and the ability to complete the job within the time frame desired by the publisher." (col 10: lines 10-15) From this disclosure it is clear that Schumacher is capable of monitoring job sites and determine if anyone of them is non-operational.

**Referring to claim 33:**

Schumacher does not expressly disclose the message processing system of claim 31 wherein the distributor module determines optimal site routing based on real time costs of site operation.

Schumacher does disclose that it is capable of matching job sites based on: job completion time, job costs, mailing and distribution costs, and mail delivery times. (col 4: lines 15-20) Schumacher also disclose that it is capable of choose an inserter for a particular job and take into account not only equipment and other resources available to each inserter, but also current workloads and the ability to complete the job within the time frame desired by the publisher (col 10: lines 10-15). Therefore it would have been obvious at the time of the invention for Schumacher to determine an optimal job site based on real time costs of site operation.

**Referring to claim 35:**

Schumacher does not expressly disclose the message processing system of claim 34 wherein the distributor module, in determining optimal routing, determines whether quality improvements can be made over past performance. However, the Examiner takes official notice that it would be obvious at the time of the invention was made for Schumacher to determine whether quality improvements can be made over past performance. It would have been in Schumacher's interest to improve quality to be able to process more jobs and produce more revenue.

**Referring to claim 42:**

Schumacher does not expressly disclose the method of claim 41 further comprising the step of determining a template for message packages with the customer relationship management system.

However, it would have been obvious at the time of the invention that a template for message packages is determined with the customer relationship management system. The template is determined such that the customer will receive consolidated mailing that is addressed to the customer.

**Referring to claim 43:**

Schumacher disclose the method of claim 42 wherein the step of determining the template comprises including marketing content developed by marketing tools in the customer relationship management system. (col 4: lines 36-40)

**Referring to claim 44:**

Schumacher does not expressly disclose the method of claim 41 wherein the step of determining the first and second criteria includes marketing business rules determined by the customer relationship management system.

However, it would have been obvious at the time of the invention that marketing business rules are determined by the customer relationship management system, it is determined by Schumacher stating that publishers can send recipient advertisements. (col 4: lines 36-40)

**Referring to claim 45:**

Schumacher does not expressly disclose the method of claim 44 including a step of preventing messages from being consolidated based on the marketing rules that

include a rule that messages including particular marketing content may, or may not, be consolidated.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business content not to be consolidated. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient as business contents could contain personal information of the recipient.

**Referring to claim 56:**

Schumacher does not expressly disclose the method of claim 50 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages including particular business content may, or may not, be consolidated.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business content not to be consolidated. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient as business contents could contain personal information of the recipient.

**Referring to claim 57:**

Schumacher does not expressly disclose the method of claim 50 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages including particular business content may, or may not, be householdered.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business content not to be househeded. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not allowing information about multiple recipients to be sent to the same address and risking compromising recipient information.

**Referring to claim 70:**

Schumacher does not expressly disclose the method of claim 69 wherein the step of determining optimal routing includes identifying whether a site or a machine at a site is non-operational, and wherein the second criteria include a failover site or channel designation, and whereby the failover site or channel designation is used for optimal routing instead of the non-operational site or machine.

However, it would have been obvious at the time of the invention for Schumacher to monitor and determine whether a site is operational and direct the mailing jobs to another site if the first site is not operation. Schumacher would be motivated to perform such method to ensure continuous job processing. Schumacher provides further motivation by disclosing that "due to continuous on-line communications, the data center can choose an inserter for a particular job and take into account not only equipment and other resources available to each inserter, but also current workloads and the ability to complete the job within the time frame desired by the publisher." (col

10: lines 10-15) From this disclosure it is clear that Schumacher is capable of monitoring job sites and determine if anyone of them is non-operational.

**Referring to claim 71:**

Schumacher does not expressly disclose the method of claim 69 wherein step of determining optimal routing is based on real time costs of site operation.

Schumacher does disclose that it is capable of matching job sites based on: job completion time, job costs, mailing and distribution costs, and mail delivery times. (col 4: lines 15-20) Schumacher also disclose that it is capable of choose an inserter for a particular job and take into account not only equipment and other resources available to each inserter, but also current workloads and the ability to complete the job within the time frame desired by the publisher (col 10: lines 10-15). Therefore it would have been obvious at the time of the invention for Schumacher to determine an optimal job site based on real time costs of site operation.

**Referring to claim 73:**

Schumacher does not expressly disclose the method of claim 72 the step of determining optimal routing includes determining whether quality improvements can be made over past site performance.

However, the Examiner takes official notice that it would be obvious at the time of the invention was made for Schumacher to determine whether quality improvements can be made over past performance. It would have been in Schumacher's interest to improve quality to be able to process more jobs and produce more revenue.

Claims 8-11, 20, 46-49 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of U.S. Pub No. 2004/0230523 to Johnson.

**Referring to claim 8:**

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose that the message processing system of claim 3 wherein the first and/or second criteria include customer preferences.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly.

[0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

**Referring to claim 9:**

Schumacher does not expressly disclose the message processing system of claim 8 wherein the first criteria includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide

convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 10:**

Schumacher does not expressly disclose the message processing system of claim 8 wherein the first criteria includes a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

**Referring to claim 11:**

Schumacher does not expressly disclose the message processing system of claim 8 wherein the second criteria includes a customer preference of physical mail or electronic delivery.

Johnson disclose allowing the consolidated bills to be send electronically or via traditional paper mail. [0029] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also allow the customer to choose between physical mail or electronic delivery. Schumacher would be motivated to perform such modification to provide the customer with more convenience in choosing form of delivery.

**Referring to claim 20:**

Schumacher does not expressly disclose the message processing system of claim 17 wherein the second criteria include a sender rule that messages that include particular business content may, or may not, be electronically delivered.

Johnson disclose allowing the consolidated bills to be send electronically or via traditional paper mail. [0029] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also allow the sender to choose between physical mail or electronic delivery. Schumacher would be motivated to perform such modification to provide the sender with more convenience in choosing form of delivery.

**Referring to claim 46:**

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose gathering customer preference data and including it in the first and/or second criteria.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly.

[0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

**Referring to claim 47:**

Schumacher does not expressly disclose the method of claim 46 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 48:**

Schumacher does not expressly disclose the method of claim 46 wherein the step of consolidating is controlled based on the first criteria which include a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

**Referring to claim 49:**

Schumacher does not expressly disclose the method of claim 46 wherein the step of determining optimal routing is based on the second criteria which includes a customer preference of physical mail or electronic delivery.

Johnson disclose allowing the consolidated bills to be send electronically or via traditional paper mail. [0029] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also allow the customer to choose between physical mail or electronic delivery. Schumacher would be motivated to perform such modification to provide the customer with more convenience in choosing form of delivery.

**Referring to claim 58:**

Schumacher does not expressly disclose the method of claim 55 wherein the step of determining optimal routing is based on a sender rule that messages that include particular business content may, or may not, be electronically delivered.

Johnson disclose allowing the consolidated bills to be send electronically or via traditional paper mail. [0029] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also allow the sender to choose between physical mail or electronic delivery. Schumacher would be motivated to perform such modification to provide the sender with more convenience in choosing form of delivery.

Claims 25-27, 29, 63-65 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of U.S. Pub No. 2002/0133472 to Stepno.

**Referring to claim 25:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose that the message processing system of claim 24 wherein the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 26:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system of claim 25 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 27:**

Schumacher does not expressly disclose the message processing system of claim 25 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 29:**

Schumacher does not expressly disclose that the message processing system of claim 25 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to

provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 63:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the method of claim 62 wherein the step of consolidating includes selecting messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 64:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the method of claim 63 wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the

messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 65:**

Schumacher does not expressly disclose the method of claim 63 wherein the step of consolidating includes determining whether a customer preference authorizes consolidating for a particular message, and whereby consolidating is disallowed if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 67:**

Schumacher does not expressly disclose the method of claim 63 wherein the step of consolidating includes determining whether a customer preference authorizes householding for a particular message, and thereby householding is disallowed if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art

that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

Claims 28, 30, 66 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Stepno in further view of Johnson.

**Referring to claims 28 and 30:**

Schumacher combined with Stepno disclose sending advertisements with the message to the recipient. (Schumacher col 4: lines 36-40) Schumacher combined with Stepno does not expressly disclose the message processing system of claim 27 wherein, if the customer preference does not authorize consolidation or householding, the consolidator generates content to be included in the message that describes benefits of consolidation or householding.

Johnson disclose that sellers often offer discounts for quick payment. [0006] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher combined with Stepno to send an advertisement describing the advantages of message consolidation to the recipient, such as discounts offered.

**Referring to claims 66 and 68:**

Schumacher combined with Stepno disclose sending advertisements with the message to the recipient. (Schumacher col 4: lines 36-40) Schumacher combined with

Stepno does not expressly disclose if the customer preference does not authorize consolidation or householding, the consolidator generates content to be included in the message that describes benefits of consolidation or householding.

Johnson disclose that sellers often offer discounts for quick payment. [0006] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher combined with Stepno to send an advertisement describing the advantages of message consolidation to the recipient, such as discounts offered.

#### **(10) Response to Argument**

With regards to claims 3, 41, 12 and 50, the appellant argues that the Examiner rejected the claims through improper hindsight and has not shown any prior art, or any relevant basis for finding the features in the claims were known or obvious. The Examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). (Emphasis added) In this case, it is well known to one of ordinary skill in the art the importance of recipient privacy and therefore Schumacher would be motivated to allow or not allow certain marketing content to be consolidated to protect the recipient's privacy on

marketing contents that could contain personal information, such as social security numbers or account numbers.

Furthermore, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With regards to the claims, Schumacher does not expressly disclose the message processing system wherein the first criteria includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information

Furthermore, one of ordinary skill in the art would have recognized that applying the known technique of protecting the recipient's privacy would have yielded predictable results and resulted in an improved system. Further, protecting the recipient's privacy

by not allowing consolidation of messages would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow a message system to provide convenience and protect privacy and personal information of the recipients.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rutao Wu

/Rob Wu/

Examiner, Art Unit 3628

Conferees:

John Hayes, Supervisory Patent Examiner, 3628

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